

Rec



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,076	02/16/2001	Vincent Dicks	098023/184	3071

31013 7590 06/07/2004

KRAMER LEVIN NAFTALIS & FRANKEL LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
919 THIRD AVENUE  
NEW YORK, NY 10022

EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 06/07/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

PEL

<b>Office Action Summary</b>	Application No. 09/785,076	Applicant(s) DICKS ET AL.	
	Examiner Philip B Tran	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because the abstract is too long (more than 150 words). Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 U.S.C. § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3 are rejected under 35 U.S.C. § 102(e) as being anticipated by Teper et al (Hereafter, Teper), U.S. Pat. No. 5,815,665.

Regarding claim 1, Teper teaches a method of providing brokerage services to a customer (= providing trusted brokering services over a distributed network between user and service provider) [see Abstract], the method comprising:

providing a communications link between a non-broker party and a customer (= communications link between a service provider (SP) site (50) and a user computer (40)) [see Figs. 3-4];

providing a communications link between the non-broker party and a broker party (= communications link between a service provider (SP) site (50) and an online broker site (60)) [see Figs. 3-4]; and

performing a brokerage service by the broker party in response to communications between the customer and the non broker party (= providing user authentication and billing services to allow users to anonymously and securely purchase

online services from the service providers (SP) sites) [see Abstract and Col. 2, Lines 31-56 and Col. 5, Lines 17-67].

Regarding claim 2, Teper further teaches the step of performing a brokerage service includes establishing a communications link between the broker party and the customer (= communications link between an on line broker site (60) and a user computer (40)) [see Figs. 3-4].

Regarding claim 3, Teper further teaches the communications links are provided over the Internet (= public network such as Internet (30)) [see Fig. 1 and Abstract and Col. 2, Lines 31-56].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper et al (Hereafter, Teper), U.S. Pat. No. 5,815,665 in view of Tobin, U.S. Pat. No. 6,141,666.

Regarding claim 4, Teper further teaches a method of providing brokerage services to a customer (= providing trusted brokering services over a distributed network between user and service provider) [see Abstract], the method comprising:

a non-broker party providing an interface to a user, the interface including a brokerage services interface (= interface links among a service provider (SP) site (50) and a user computer (40) and an online broker site (60)) [see Figs. 3-4];

the non-broker party exchanging communications with a customer (= exchanging communications link between a service provider (SP) site (50) and a user computer (40)) [see Figs. 3-4];

the non-broker party transmitting certain of said communications to a broker party (= passing communications link between a service provider (SP) site (50) and an online broker site (60)) [see Figs. 3-4]; and

the broker party performing a brokerage service for the non-broker party (= providing user authentication and billing services to allow users to anonymously and securely purchase online services from the service providers (SP) sites) [see Abstract and Col. 2, Lines 31-56 and Col. 5, Lines 17-67].

Teper does not explicitly teach both the user interface and the brokerage services interface being branded with a mark of the non-broker party. However, Tobin, in the same field of providing marketing services online endeavor, discloses dynamic customization of internet sites participating in the program of marketing services wherein private label and names are being branded [see Tobin, Col. 5, Lines 19-30 and Col. 5, Line 46-66 and Col. 12, Lines 47-51]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of customization web sites and displaying brand names (trademarks) on the web pages (user interface screens), disclosed by Tobin, into the teaching of providing brokerage services to a customer as disclosed by Teper, in order to take advantage of the consumer's familiarity with the participating internet sites for building the brand name and identity of participant's own service and promoting the participant's own site and generating traffic by attraction [see Tobin, Col. 6, Lines 1-12].

Regarding claim 5, Teper further teaches the step of performing a brokerage service includes establishing communications between the broker party and the customer (= communications link between an on line broker site (60) and a user computer (40)) [see Figs. 3-4].

Regarding claim 6, Teper further teaches the communications are provided over the Internet (= public network such as Internet (30)) [see Fig. 1 and Abstract and Col. 2, Lines 31-56].

***Other References Cited***

6. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

A) Breen et al, U.S. Pat. No. 6,615,188, discloses online trading with a brokerage system.

B) Salmon et al, U.S. Pat. No. 5,592,375, discloses interactively brokering goods or services between buyers and sellers.

C) Ojha et al, U.S. Pat. No. 6,598,026, discloses brokering transaction between buyers and sellers via the Internet.

D) Page et al, U.S. Pat. No. 5,329,619, discloses cooperative processing interface and communication broker for heterogeneous computing environments.

E) Segev et al, "Brokering Strategies in electronic Commerce Markets", ACM, 1999, discloses online brokering strategies.

F) Maes et al, "Agents That Buy and Sell", ACM, 1999, discloses online business transaction with brokering agent.

G) Singh et al, "E-Commerce over Communicators: Challenges and Solutions for User Interfaces", discloses business transactions with brokerage services.

H) Stasiak et al "A Broker for Tracking, Delivering and Using Regulations Over the World Wide Web", IEEE, 1996, discloses online brokerage services.



7. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS, OR THIRTY DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (703) 308-6662.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Philip Tran*  
Philip B. Tran  
Art Unit 2155  
May 28, 2004